

## REMARKS

The following remarks are submitted to address the above amendments and issues raised in the Official Action mailed April 9, 2003. A Request for Extension of Time for three months, extending the time in which to respond to this Official Action to October 9, 2003, along with the appropriate fee, is submitted herewith.

Claims 1-34 are pending in this application.

Claims 7, 9-13, 15, 20, 22-26, and 31-34 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 1-5, 7, 9-11, 14-18, 20, 22-24, 27-29, 32, and 33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Berger (U.S. Patent No. 5,084,988).

Claims 6, 12, 19, 25, 30, and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Berger in view of official notice/examiners declaration/attached photocopies of soles of shoes over 10 years old.

Claims 8, 13, 21, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Berger in view of either Rosen (U.S. Patent No. 4,931,773) or Sigoloff (U.S. Patent No. 4,712,314).

These amendments are made merely to clarify the subject matter of this application. No new matter has been added. Support for requested amendments can be found in the original claims and throughout the present specification and drawings. Applicant respectfully requests consideration of the application in light of the above amendments and the following remarks.

### **Claims 7, 9-13, 15, 20, 22-26, and 31-34 —35 U.S.C. § 112, Second Paragraph**

The rejections of claims 7, 9-13, 15, 20, 22-26, and 31-34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention are respectfully traversed.

### **Claim 7**

The Official Action states that in claim 7, the phrases “further comprising a pair of shoes” and “on each of a left and a right pair of shoes” contradicts the preamble of “The shoe...” rendering the claim vague and indefinite because it is not clear if Applicant is claiming a single shoe or a pair of shoes. (Official Action, para. 1.)

Applicant has amended claims 7 to recite “The shoe of claim 1, further comprising a left shoe or a right shoe.” As such, the body of claim 7 is consistent with the preamble, and Applicant respectfully submits that claim 7 is definite and clear.

### **Claims 9-11, 22-24, 32, 33, and 34**

The Official Action states that claims 9-11, 22-24, 32, and 33 and in claims 12, 25, and 34, the phrase “corresponding to the plurality of shoe size indicator lines comprise standard shoe sizes for toddlers, children, youth, or adults, and gender-specific lengths and widths” are vague and indefinite, and it is not clear what further structural limitations Applicant intends to encompass with such language. (Official Action, para. 1.)

Applicant has amended claims 9-12, 22-25, and 32-34 by deleting any reference to “toddlers, children, youth, or adults” and to “gender-specific” lengths and widths. Applicant respectfully submits that, as amended, these claims are clear and definite.

### **Claims 11 and 24**

The Official Action states that in claims 11 and 24, the phrase “patterns having appeal to toddlers, children, youth, or adults that would typically wear the shoe sizes” is vague and indefinite because it claims the shoe in reference to an appeal of a person which is undefined, unknown, and unbounded. It is not clear what structural limitations Applicant intends to encompass with such language. (Official Action, para. 1.)

Applicant has claims 11 and 24 to recite “. . . the outsole further comprising images of (a) stuffed animals, toys, and stars, (b) numbers, letters of the alphabet, and geometric figures, (c) flowers, (d) sports characters, or (e) geometric patterns thereon.” By deleting any reference to

“patterns having appeal to toddlers, children, youth, or adults that would typically wear the shoe sizes” Applicant respectfully submits that claims 11 and 24 are definite and clear.

While claims 15 and 31 are listed as being rejected under 35 U.S.C. § 112, second paragraph, because claims 15 and 31 do not comprise any of the language on which the § 112 rejections are made in paragraph 1, it is not clear from the Official Action the basis for such rejections. Claim 13 is dependent on claim 12, and claim 26 is dependent on claim 25. Therefore, Applicant respectfully submits that claims 7, 9-13, 15, 20, 22-26, and 31-34, as amended herein, are definite and particularly point out and distinctly claim the subject matter which Applicant regards as the invention. For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 7, 9-13, 15, 20, 22-26, and 31-34 under 35 U.S.C. § 112, second paragraph.

**Claims 1-5, 7, 9-11, 14-18, 20, 22-24, 27-29, 32, and 33 —35 U.S.C. § 102(b)**

The rejections of claims 1-5, 7, 9-11, 14-18, 20, 22-24, 27-29, 32, and 33 under 35 U.S.C. § 102(b) as being anticipated by Berger are respectfully traversed.

Claims 1, 14, and 27, as amended above, claim, respectively, a shoe, a shoe size indication system, and a method for determining a proper numerical shoe size for a person’s foot “. . . wherein the shoe sizes corresponding to the plurality of shoe size indicators comprise standardized shoe sizes. . . .”

The Official Action states that Berger shows shoe soles and a method using shoe soles having a heel indicator (boundary between elements 4 and 5), and a plurality of calibrated lines (6 and boundary between elements 3 and 5) with indicia comprising calibrated numbers and/or lines (6 and 7, column 3, lines 1-10) as claimed. (Official Action, para. 3.)

Nowhere does Berger disclose a shoe, a shoe size indication system, and a method for determining a proper numerical shoe size for a person’s foot, wherein the shoe sizes corresponding to the plurality of shoe size indicators comprise standardized shoe sizes, as in

claims 1, 14, and 27. In contrast, Berger discloses a shoe having a front transparent area within the outsole with calibrated markings, such as lines and/or numbers, that form a warning zone for indicating that a shoe has become too small. The shoe can also have a rear transparent area within the outsole through which heel location can be observed. The markings allow monitoring of the distance of the toe tips from the upper tip to see whether the shoe has become too small. (Berger, col. 1, line 38 –col. 2, line 4; col. 3, lines 1-11 (emphasis added).) A nontransparent edge (5) in the front sole area can be used for calibration or marking of the “correct shoe size” by observing whether toe tips are present in the transparent area or grown into the nontransparent area. (Berger, col. 3, lines 62-68.)

Accordingly, Berger does not teach each and every element of the present invention in independent claims 1, 14, and 27, as amended. Therefore, Berger is deficient as a reference with respect to claims 1, 14, and 27. Because claims 2-5, 7, 9-11, 15-18, 20, 22-24, 28-29, 32, and 33 depend from claims 1, 14, and 27, Berger is deficient as a reference with respect to these claims as well.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 1-5, 7, 9-11, 14-18, 20, 22-24, 27-29, 32, and 33 under 35 U.S.C. § 102(b).

**Claims 6, 12, 19, 25, 30, and 34—35 USC § 103(a)**

The rejections of claims 6, 12, 19, 25, 30, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Berger in view of official notice/examiners declaration/attached photocopies of soles of shoes over 10 years old are respectfully traversed.

The Official Action states that Berger shows shoe soles and method of using such substantially as claimed except for printing the actual size of the shoe on the bottom of the shoe sole and that it is extremely well known and conventional to print the shoe size on the bottom of soles as shown by the attached pictures of the soles of shoes which were sold in the U.S. in the early 1990's; and that it would have been obvious to print the shoe size on the outsole as is well known and conventional in the shoes of Berger to make it easier to locate properly sized shoes in a store. (Official Action, para. 5.)

Claims 6, 19, and 30 have been canceled. Claims 12, 25, and 34 have been amended to remove any reference to the size of a shoe indicated on the shoe outsole. Moreover, Berger does not disclose a shoe, a shoe size indication system, and a method for determining a proper numerical shoe size for a person's foot, wherein the shoe sizes corresponding to the plurality of shoe size indicators comprise standardized shoe sizes, as in claims 12, 25, and 34. Accordingly, Berger is deficient as a reference with respect to these claims. Therefore, Applicant respectfully submits that claims 12, 25, and 34 are not obvious over Berger in view of official notice/examiners declaration/attached photocopies of soles of shoes.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 12, 25, and 34 under 35 USC § 103(a).

**Claims 8, 13, 21, and 31—35 USC § 103(a)**

The rejections of claims 8, 13, 21, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Berger in view of either Rosen or Sigoloff are respectfully traversed.

As discussed herein, Applicant respectfully submits that Berger does not teach each and every element of independent claims 1, 14, and 27, as amended, and is therefore deficient as a reference with respect to these independent claims. Claims 8, 13, 21, and 31 depend from claims 1, 14, and 27, and are therefore also not anticipated by Berger. Neither Rosen or Sigoloff cure the deficiencies of Berger as a reference by teaching or suggesting a shoe, a shoe size indication system, and a method for determining a proper numerical shoe size for a person's foot, wherein the shoe sizes corresponding to the plurality of shoe size indicators comprise standardized shoe sizes, as in claims 1, 14, and 27. Thus, Applicant respectfully submits that claims 1, 14, and 27, and dependent claims 8, 13, 21, and 31 are not obvious over Berger in view of either Rosen or Sigoloff.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 8, 13, 21, and 31 under 35 USC § 103(a).

**CONCLUSION**

Applicant submits that a full and complete response has been made herein to the Official Action and, as such, all pending claims in this application are now in condition for allowance. Therefore, Applicant respectfully requests early consideration of the present application, entry of all amendments herein requested, withdrawal of all rejections, and allowance of all pending claims.

The Office is respectfully invited to contact J. Michael Boggs at (336) 747-7536, to discuss any matter relating to this application.

Respectfully submitted,

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Date

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